Question Q217

National Group: Turkish Group

Title: **The patentability criterion of inventive step / non-obviousness**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. *What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?*

According to the Turkish Patent Decree Law No.551 (hereinafter referred as "DL 551"), namely in Art. 9 concerning inventive step which reads: "an invention shall be deemed to surpass the State-of-the-Art (to involve inventive step / not obvious) when it is the result of an activity which is not obviously derivable from the State-of-the-Art, by a person skilled in the art."

2. *Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?*

The patentability criterion of inventive step has evolved since the DL 551 is accepted in 1995. Before that there was no inventive step criterion requirement for patentability.

3. *Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines*?

Our patent-granting authority has no guidelines about inventive step/ non-obviousness.
On the other hand, the draft copy of guidelines for the patent examination procedure of the Turkish Patent Institute includes inventive step that is explained in detail. Problem solution approach is mentioned as the way of assess the inventive step. Unfortunately, it cannot be foreseen when the new draft guideline will come into effect.

4. *Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?*

Before answering these questions it is consequential to clarify the essential features of Turkish examination and court system.

In Turkey, patent litigations related to infringement and nullification cases are prosecuted at the Intellectual Property and Law Courts by judges who know the Intellectual Property Law. However, they do not have technical backgrounds such as basic science, pharmacy or mechanics. For this reason, the judges generally need assistance of expert groups for patent litigations. Expert groups generally consist of three members one of which is a patent attorney with technical background; the other is a lawyer and the third one is a university member of a related technical field. It is aimed that this multi-disciplinary expert group investigates the file in all its aspects. The judges may instruct the expert group on how inventive-step investigation should be made. They may define the skilled person in the art in detail and demand from the expert group to investigate the inventive step from this hypothetical skilled person's point of view.

On the other hand, the examination of only a restricted amount of the technical fields is executed by Turkish Patent Institute (hereinafter referred as "TPI"). Whereas the examinations of most of the patent applications are conducted by the contracted examination offices like Swedish, Danish, Russian and Austrian patent offices. Even though these offices prosecute the examinations of the patent applications according to the articles of DL 551, the novelty and inventive step approaches of these offices may differ from each other and this situation causes non-homogeneity for the examination procedure.

As it is detailed above, the examination and litigation procedures in Turkey are different from each other although they both are predicated on the DL 551. DL 551 does not suggest any procedure or perspective on inventive step assessment.

Construction of claims and interpretation of prior art

5. *How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?*

The claims are interpreted as it would be understood by the skilled person in the art instead of its literal wording in our jurisdiction. According to the DL 551, namely in Art. 83 concerning the construal of the claims which reads: "Claims shall not be interpreted as being confined to their strict literal wording. However, for determining the scope of protection of the subject application for patent or of the patent, where those characteristics, though contemplated by the inventor, are not expressed in the claim(s) and where such characteristics can be only revealed from an interpretation of the description and drawings by a person skilled in that technical field, the claim(s) shall not be deemed to include/cover such characteristics."

6. *Is it possible to read embodiments from the body of the specification into the claims?*

Yes, it is possible. In practice, the embodiments are read from the body of specification into the claims.

7. *How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?*

There are no specific rules or standards in Turkish jurisdiction about the interpretation of the prior art. However, in practice, the prior art is interpreted as it would be understood by the skilled person in the art. Consequently, the reliance on inherent disclosures is also permitted.

8. *Do the answers to any of the questions above differ during examination versus during litigation?*

The difference between examination and litigation procedure is briefly explained in question 4.

Combination or modification of prior art

9. *Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?*

Yes, a single prior art document can be used to prove lack of inventive step or obviousness. Common general knowledge can be used to provide the missing teaching. During the litigation, the expert group can assert that the missing teaching(s) is trivial for the person skilled in the art. Since, one member of the expert group is usually a university member in the related technical area, the argumentation can be sufficient. It is hard to base an argumentation on the level of common general knowledge.

10. *What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?*

There are no well defined standards or written instructions about how the prior art references will be combined. The general tendency is to accept combination of documents from closely related or neighbouring technical fields. If explicit teaching exists, it is a strong argumentation. But it is not a requirement.

11. *When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?*

There are no well defined standards or written instructions about the closeness of the technical fields. The general tendency is to accept combination of documents from closely related or neighbouring technical fields. There is no data regarding to the relevance of the problem the inventor of the claim in question was trying to solve.

12. *Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?*

There is no specific rule regarding the number of documents that can be combined. In practice of course combination reasonable number of documents is expected. On the other hand the standard does not change when more than two documents are combined.

13. *Do the answers to any of the questions above differ during examination versus during litigation?*

The difference between examination and litigation procedure is briefly explained in question 4.

Technical Problem

14. *What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?*

There are no well defined standards or written instructions about the role of technical problem in determining inventive step. But during litigation, the technical problem solved by the invention is taken into consideration and if the technical problem to be solved by the invention is perceived as simple or trivial, this may be used as an argumentation to justify obviousness.

15. *To what degree, if any, must the technical problem be disclosed or identified in the specification?*

In the current state of legislation there is no legal obligation for the identification of technical problem. However the established practice is to identify the technical problem in the specification. Moreover, it is worthwhile to note that the specific technical problem which leads to the grant of the patent does not have to be defined in the specification and can be argued later during the examination or litigation.

Advantageous effects

16. *What role, if any, do advantageous effects play in determining inventive step or non-obviousness?*

The advantageous effects are not defined nor mentioned in our patent law but they are nevertheless present in the customary practice and in general they play a positive role in convincing the examiner during prosecution or the court appointed expert during court proceedings in determining inventive step or non-obviousness.

17. *Must the advantageous effects be disclosed in the as-filed specification?*

Although it is always better to have the arguments already disclosed in the as-filed specification, there is no “must” in disclosing the advantageous effects in it.

18. *Is it possible to have later-submitted data considered by the Examiner?*

We do not have sufficient information in hand to answer this question.

19. *How "real" must the advantageous effects be? Are paper or hypothetical examples sufficient?*

Hypothetical or paper examples might be sufficient as long as the person skilled in the art (in practical terms the examiner during prosecution or the court appointed expert during court proceedings) can be convinced that the advantageous effects can be realized.

20. *Do the answers to any of the questions above differ during examination versus during litigation?*

Due to lack of written standards on the above subject-matter, there are differences between examination during prosecution and court proceedings in that it might be more difficult to have later submitted data concerning the advantageous effects considered by the examiner during prosecution whereas during litigation the court appointed experts are rather inclined to accept it.

Teaching away

21. *Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?*

Teaching away is neither defined nor mentioned in our patent law and is not officially recognized in our jurisdiction. Nevertheless, such argumentation can be used especially in court proceedings as a convincing argumentation. However the teaching shall be explicit.

22. *Among the other factors supporting inventive step / non-obviousness, how important is teaching away?*

There is no sufficient information in hand to answer this question as far as examination during prosecution is concerned but teaching away seems less important in comparison to other factors supporting inventive step / non-obviousness in court proceedings.

23. *Is there any difference in how teaching away is applied during examination versus in litigation?*

The difference between examination and litigation procedure is briefly explained in question 4.

Secondary considerations

24. *Are secondary considerations recognized in your jurisdiction?*

No. Secondary considerations are not officially recognized in our jurisdiction.

25. *If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the claimed invention and the secondary considerations required?*

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26. *Do the answers to any of the questions above differ during examination versus during litigation?*

The difference between examination and litigation procedure is briefly explained in question 4.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

Regarding the consideration in determining inventive step / non-obviousness, there is no other issue, tests or factors are taken into consideration in our jurisdiction.

If yes, please describe these issues, tests, or factors.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and , if so, provide a brief summary of such interpretation.

No such test and interpretation exists in our jurisdiction.

29. Does such test differ during examination versus during litigation?

No such test and interpretation exists.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

There are no other areas to be described other than the above. (Construction of claims and interpretation of prior art, combination or modification of prior art, technical problem, advantageous effects, teaching away, secondary considerations etc.)

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

The divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority are always problematic as it is explained above.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

There are two ways of granting a patent in Turkey first of which is via national application and the second one is by validation of an EP granted patent. On national application, in most cases the application is examined by the contracted patent offices. If there are any deficiencies in the first examination report, the application may be sent to another examination office. Maximum three examinations may be conducted. After the third examination the authority decides to grant or reject the application.

Whereas an EP patent granted within the well-defined EPO procedure is validated at the TPI.

33. If yes, is this problematic?

Yes it is problematic. The ways that are described above result in granting the application by different claims in EPO and TPI.

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Patent harmonization is inevitable. Even if it is one small step at a time, harmonization is desirable to establish a common understanding and hence a just system.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

We believe indeed it is possible to find a common standard. Actually step by step harmonization does occur. One of the striking evidences is the Supreme Court's ruling in 2007 regarding KSR International Co. v. Teleflex, Inc.[1]

In accordance with this decision in the US legislation the Examiners' obviousness analysis has now been modified to include "a reasonable expectation of success" along with the broader aspects of inventive step. Although true harmonization of non-obviousness with international patent practice is still far off, the U.S. has moved one step closer.

Hence we believe via developments like this the two, previously considered to be far apart legislations, soon will come closer and it will be possible to find a standard that is universally acceptable.

[1] KSR International Co. v. Teleflex, Inc., 127 S.Ct. 1727, 1741, 82 USPQ.2d 1385, 1396 (2007)

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

The definition in EPC and EPO Examination Guidelines is broadly acceptable in our opinion. If we shall quote the Guidelines;

"An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the patent application.

The "person skilled in the art" should be presumed to be a skilled practitioner in the relevant field, who is possessed of average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything in the "state of the art", in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem.

Thus the question to consider, in relation to any claim defining the invention, is whether before the filing or priority date valid for that claim, having regard to the art known at the time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is not allowable for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty, it is fair to construe any published document in the light of knowledge up to and including the day before the filing or priority date valid for the claimed invention and to have regard to all the knowledge generally available to the person skilled in the art up to and including that day.“

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

The definition in EPC and EPO Examination Guidelines is broadly acceptable in our opinion. Problem solution approach shall be used as a general standard for determination of the inventive step.

SUMMARY

Current Decree Law or the case law does not specify the standards, methods or approaches of inventive step requirement. Due to lack of written standards on inventive step, there are differences between examination during prosecution and court proceedings. The group believe that written standards and methods on inventive step are essential to obtain predictable results from examination during prosecution and court proceedings. On the other hand, the draft copy of guidelines for the patent examination procedure of the Turkish Patent Institute includes inventive step that is explained in detail. Problem solution approach is mentioned as the way of assess the inventive step. Unfortunately, it cannot be foreseen when the new draft guideline will come into effect.

RESUMÉ

Le décret-loi ou la jurisprudence en cours ne définit pas les normes, méthodes et approches relatives à l’exigence de l’activité inventive. Par manque de normes écrites concernant l’activité inventive, il y a des différences entre l’examen de la demande et l’examen pendant l’action en justice. Le groupe croit en l’importance de normes écrites et méthodes concernant l’activité inventive afin d’obtenir des résultats prévisibles depuis l’examen de la demande et l’examen pendant l’action en justice. D’autre part, le projet sur les directives pour la

procédure d'examen des brevets de l'Institut Turc des Brevets comprend l'activité inventive expliquée en détail. L'approche Problème -Solution est mentionnée en tant que moyen d'évaluation de l'activité inventive. Malheureusement, il n'est pas possible de prévoir quand ce nouveau projet sur les directives entrera en vigueur.

ZUSAMMENFASSUNG

Die Rechtsverordnung oder das Fallrecht, die in Kraft sind, bestimmen die Normen, Methoden und Annäherungen bezüglich des Erfordernisses der erfinderischen Tätigkeit nicht. Aufgrund des Mangels an schriftlichen Normen in Bezug auf die erfinderische Tätigkeit, gibt es Unterschiede zwischen der Prüfung während der Verfolgung und der Prüfung während dem Gerichtsverfahren. Die Gruppe glaubt, dass schriftliche Normen und Methoden über die erfinderische Tätigkeit wesentlich sind, um von der Prüfung der Anmeldung und der Prüfung während der Gerichtsverfahren voraussehbare Ergebnisse zu erzielen. Andererseits umfasst der Vorentwurf des Türkischen Patentinstituts bezüglich der Richtlinien für das Patentprüfungsvorgehen eine ausführlich erklärte erfinderische Tätigkeit. Die Problem-Lösung Annäherung wird als der Bewertungsweg der erfinderischen Tätigkeit festgestellt. Leider ist es nicht voraussehbar wenn die neue Entwurfsrichtlinie in Kraft treten wird.